

**REMARKS**

The indication that the drawings filed June 27, 2000 are accepted is acknowledged. Applicants also appreciate the return of the initialed copy of PTO-1449 indicating that the Examiner considered the prior art submitted by the applicants.

The following objections/rejections were noted in the first Office Action. Claim 12 was rejected as being indefinite for failing to provide a proper antecedent basis for a claim term. Claims 1, 14-17 and 22 were rejected under 35 U.S.C. 102(b) as being anticipated by Van Lierop et al. - US 5,557,169 ("Van Lierop"). Claims 2 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Van Lierop. Claims 3-6, 18-21 and 23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Van Lierop in view of Tessmann - US 3,259,969 ("Tessman"). Claims 7-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Van Lierop in view of Freeman - US 3,132,409 ("Freeman"). Claim 12 was rejected under 35 U.S.C. 103(a) as being over Van Lierop in view of Anderson et al. - US 2,687,489 ("Anderson"). Claim 11 was objected to as being dependent upon a rejected base claim. Applicants appreciate the indication of allowable subject matter and have rewritten the subject matter in independent form.

The Applicants have carefully considered the Office Action and the prior art both cited and applied therein. In view of the remarks in this response, Applicants seek withdrawal of all rejections by the Examiner and allowance of the application.

The Examiner rejected claims 1, 14-17 and 22 under 35 U.S.C. §102(b) as being unpatentable over Van Lierop. Van Lierop is directed primarily toward manufacturing discharge lamps with less wastage.

Independent claim 1 is drawn to a method for making a lamp electrode comprising multiple cutting, joining and securing steps. Specifically, Claim 1 is directed to cutting a first material to a desired length; joining a first end of a second material to the second end of the first material; cutting a second material to a desired length; joining a first end of a third material to the second end of the second material; cutting a third material to a desired length and securing a coil to the second end of the third material.

The Examiner, citing column 5, lines 6-18 of Van Lierop asserts that Van Lierop discloses a method of making a lamp electrode which anticipates Applicants' claim 1. Applicants respectfully disagree and assert that Van Lierop fails to disclose all of the elements in pending claim 1. Column 5, lines 6-18 of Van Lierop states:

The first part 32a,b of the current supply conductor 31a,b also merges into a narrowing end 37a,b at a side remote from the second part 33a,b. The electrodes 30a,b are welded to this further end 37a,b of the first part 32a,b remote from the second part 33a,b. The electrodes 30a,b are constructed as tungsten rods with a diameter of 300  $\mu\text{m}$ , each being provided with a winding at an end portion which points into the discharge space 22. For the manufacture of the current supply conductor 31a,b, a first part 32a,b was used whose further end 37a,b was identical to the end 34a,b of the first end 32a,b embedded in the end 35a,b of the second part 33a,b before the electrode 30a,b was welded to this further end.

Neither the above-cited section of Van Lierop, nor the remainder of the cited patent, discloses or suggests a cutting function with regard to the manufacture of a current supply conductor, particularly after the first and second components have been joined as set forth in claim 1. In addition, the drawings of Van Lierop do not disclose such cutting steps. Therefore, Van Lierop does not anticipate claim 1, nor would it have been rendered obvious in light thereof unless Applicants' own disclosure is improperly used in a hindsight manner. Accordingly, it is submitted that claim 1 and claims 2-22 dependent from claim 1 are in condition for allowance.

Dependent claim 2 is further directed toward the method for making a lamp electrode of claim 1 wherein the step of cutting a first material further comprises using a first collet to hold a first portion of the first material; using a second collet to hold a second portion of the first material spaced from the first portion; and cutting the first material at a point between the first and second collets. The Examiner admits that Van Lierop fails to disclose the limitations of using a first collet to hold a first portion of the first material, using a second collet to hold a second portion of the first material spaced from the first portion, and cutting the first material at a point between the first and the second collets. *Office Action* at 2. However, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to hold a first and second portion of a first material with a pair of collets and provide a cut at a location between the two collets. *Id.*

When obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. Regarding the manufacture of a lamp electrode, there is no suggestion or motivation to modify the teachings of Van Lierop to include collet devices, or any other holding or clamping device, to hold and position material to be cut. Accordingly it is submitted that claim 2 should be allowed.

Moreover, the limitation of dependent claim 18 directed toward the method for making a lamp electrode of claim 1 wherein the step of joining a first end of a second material is performed subsequent to the step of cutting a first material. Again, such a feature/step is neither shown or remotely suggested in Van Lierop, or the remaining art of record.

The Examiner rejected claim 23 under 35 U.S.C. §103(a) as being unpatentable over Van Lierop as modified by Tessmann.

Claim 23 is an independent claim drawn to a method for making a lamp electrode comprising multiple positioning, advancing, cutting, replacing, welding, and securing functions. Specifically, claim 23 calls for utilization of "collets" to assist in the aforementioned functions.

Once again, the Examiner, cites column 5, lines 6-18 of Van Lierop; however this time the Examiner argues that Van Lierop discloses a method of making a lamp electrode which, in view of Tessmann, renders claim 1 unpatentable. Rejecting claim 23, the Examiner asserts:

It would have been obvious at the time the invention was made to a person having ordinary skills in the art to incorporate the collets member and manufacturing process disclosed by Tessmann in the manufacturing process of Van Lierop in order to hold and position the rod components adjacent to each other, which provides a stable and solid hold of the material components during welding procedures.

*Office Action* at 8. Applicant respectfully disagrees with Examiner's rationale. First, there is no motivation for combining the references but for trying to meet the specific limitations of the claimed invention. Moreover, even if the references are properly combinable, they still do not meet the claim limitations of the cutting the second material after joining the first material to the second material (claim 1) or the steps of locating, welding, advancing, etc. set forth in claim 23. Accordingly, these claims and the claims dependent therefrom are deemed to be allowable over any fair teachings attributable to the references.

All formal and informal matters having been addressed, this application is in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

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